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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,353	04/20/2004	Michael B. Zemel	31894-199297	2617
26694	7590	10/08/2008		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER GEORGE, KONATA M	
			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			10/08/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/827,353

Applicant(s)

ZEMEL ET AL.

Examiner

KONATA M. GEORGE

Art Unit

1616

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16-19, 21 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15, 20 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-28 are pending in this application.

### ***Action Summary***

Any rejections of record that are not repeated below are considered withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 14, 15, 20 and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 24 as currently written are vague and indefinite. The claims contain the phrase "at least about". "At least about" is vague and indefinite because it is unclear what constitutes the lower limit for the particular amount being claimed. For example, claim 1 recites "at least about 773 mg per day"; however it is unclear if the lower limit is "at least 773 mg per day " or "about 773 mg per day". Claims 2-12, 14, 15, 20 and 22-27 are rejected because they depend from a rejected claim.

Claims 1 and 24 contain the phrase "below ad lib". Ad lib is a commonly used term that is understood to be the unrestricted intake of food or calories available to the point of satisfaction. However, claims 1 and 24 specifically restrict the amount of caloric intake to be about 200 kcal to about 2500 kcal. The presence of "below ad lib" before a

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restricted range causes the claim to be vague and indefinite. Claims 2-12, 14, 15, 20 and 22-27 are rejected because they depend from a rejected claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12, 14, 15, 20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiansen et al. (US 6299914) in view of Goodman and Gilman (1990).

Applicant claims a food package comprising a container and a calcium-containing dietary food product.

***Determination of the scope and content of the prior art***

**(MPEP §2141.01)**

Christiansen et al. teach in example 5 (col. 8, lines 37-63), a 2% milk fortified with a calcium amino acid, which provides a product having 600 mg of calcium per 8-fl oz. of milk. It is also taught that the composition is packaged in a container.

***Ascertainment of the difference between the prior art and the claims***

**(MPEP §2141.02)**

Christiansen et al. do not teach a description of the product, the dietary plan or who is to take the product as claimed. It is for this that Goodman and Gilman are joined.

Goodman and Gilman teach on page 1525 a table which shows the recommended daily dietary allowances (RDA) for infants, children, males and females (including pregnant and lactating). It is taught that for females, the RDA of calcium is in the range of 800 to 1,200.

***Finding of prima facie obviousness***

***Rational and Motivation (MPEP §2142-2143)***

With respect to the Christiansen et al. not comprising a description of the product as claimed, it is the position of the examiner that this limitation is obvious and well known in the art. Applicant claims that the description indicates that the calcium containing dietary plan can induce weight loss, reduce weight gain, etc. It should be

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noted that in column 2, lines 58-61 of Christiansen et al. teach that for persons who are dieting it would be advantageous to consume milk. It is therefore the position of the examiner that since this limitation was known, the description as claimed is not at patentable limitation. In re Nagi 217 USPQ 401, 404 (Fed. Cir. 2004).

The dietary plan as claimed by applicant consist of administering the calcium-containing product to an individual comprising one or more servings in an amount above suboptimal levels of at least about 773 mg per day. Christiansen et al. disclose that the calcium-containing product contains 600 mg per serving, but not 773 mg as claimed. To solve this deficiency, Goodman and Gilman is relied upon to teach the RDA of calcium for females, which is in the range of 800 to 1,200 mg. With this information, one of ordinary skill in the art could take the 8-fl oz. serving size of 2% milk containing 600 mg of calcium to meet most of the limitation as claimed. The additional 173 mg per day could come from other calcium containing sources such as yogurt, cheese, etc. If the individual consumed 8-fl oz. of milk a day in addition to some yogurt or cheese, the limitation as claimed of at least about 57 servings of dairy a month would also have been.

### ***Conclusion***

Clams 1-12, 14, 15, 20 and 22-27 remain rejected.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Konata M. George/  
Primary Examiner, Art Unit 1616